REMARKS

The Examiner has rejected claims 1-15 under 35 USC 112, first paragraph, as being non-enabling for all EP4 agonists for the treatment of ocular hypertension or glaucoma.

In particular, the Examiner argues that the examples are limited to using only one EP4 agonist.

However, the applicants have disclosed that 27 compounds, that are EP4 agonists, may be used to lower elevated intraocular pressure. (See page 30, lines 20-23, of the specification.)

In addition, the applicant's have disclosed that the EP4 agonists of U.S. Patent 6,410,591B1, which is commonly assigned to the Assignee of the present patent application may be used to lower elevated intraocular pressure. (See page 35, lines 9-11, of the specification.) Finally, applicants have disclosed that the selective EP4 agonist, GR 50209X, may be used to lower elevated IOP. (See page 35, lines 11-14, of the specification.)

In addition, applicants disclose at pages 33-34, an assay for determining compounds having the required EP4 agonist activity for use in the lowering elevated IOP.

Thus, the applicants have disclosed many EP4 agonists which may be used for lowering elevated IOP and an assay for determining any other suitable EP4 agonist compounds. (It will be noted that the disclosed compounds vary significantly in their chemical structure, but have a common feature, i.e., they are EP4 agonists. Therefore, claiming the class of EP4 agonist, is the correct way to define the scope of the present invention.)

The Examiner refers to page 4 of the specification for the point that not all prostaglandins are useful to treat ocular hypertension or glaucoma, due to ocular surface hyperemia, etc. However, this reference does not say that all prostaglandins do not lower IOP. It says the use of certain prostaglandins are limited in treating glaucoma. It also does not refer to EP4 agonists. In fact, the class of prostaglandins referred to in this reference is $PGF_{2\alpha}$ and its prodrugs.

The Examiner has rejected claims 13 and 14 under 35 USC 102(b) as anticipated by Maruyama et al. These claims are hereby cancelled, without prejudice, and, thus, this rejection is moot.

The Examiner rejected claim 1 under 35 USC 102(b) as anticipated by Stjernschantz et al. The Examiner argues that this reference teaches the use of PGEs for the treatment of glaucoma or ocular hypertension. The Examiner is reminded that the claims of the present invention are limited to the use of EP4 agonists, not to any PGE. No where does the reference disclose that any of the PGs described therein are EP4 agonists. In fact, the Example that the Examiner refers to, i.e. the 17-phenyl PGF_2 of Example 5, is EP_1 agonist. (See "Characterization of receptors involved the direct and indirect actions of prostaglandins E and I on the guinea-pig ileum" by Lawrene, et al, Br. J. Pharmacol. (1992), 105, 271-8, which is enclosed herewith.) Thus, the Stjernschantz et al patent does not anticipate the claims of the present invention.

The Examiner has rejected claims 1-15 for obvious-type double patenting over U.S. Patents 6,410,591 and 5,767,920, which are commonly assigned. The applicants have filed, with this amendment, a Terminal Disclaimer to overcome this rejection.

It is believed the claims are in condition for allowance. The Examiner is asked to withdraw her rejections and pass the claims to issue.

Respectfully submitted,

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CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS, ON THE DATE SHOWN BELOW, BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS IN AN ENVELOPE ADDRESSED TO: MAIL STOP AMENDMENT-FEE, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on 12/22/04 Signature of Person Making Deposit: Bonnie Ferguson Printed Name of Person Making Deposit: BONNIE FERGUSON Date: 12/22/04